

## **REMARKS**

### **Objection To Drawings**

Applicant is submitting herewith a marked-up drawing removing an incorrect reference number. Formal replacement drawing is also submitted herewith.

### **Specification**

Applicant appreciates the Examiner pointing out informalities concerning the length of the abstract and the mis-matched reference number 49. Applicant has amended the Abstract and the specification to correct these informalities.

### **Claim Objections**

Applicant appreciates the Examiner pointing out typographical errors with respect to frustoconical in some places. These errors have been corrected in the amended claims.

### **Claim Status**

This application was filed with 40 claims. Claims 1-40 stand rejected under 35 U.S.C. § 112 ¶¶ 1 and 2 due to informalities in the drawings and under §§ 102 and 103 in view of prior art.

### **Claim Rejections - 35 U.S.C. § 112**

The Examiner has rejected Claim 15 based on use of the term gatherers without antecedent basis. The Applicant directs the Examiner's attention to pages 11 and 12 of the specification and to reference numeral 96 on Figs. 2-5. Claim 15 has also been amended to address the lack of antecedent basis.

## **Claim Rejections - 35 U.S.C. § 102**

The Examiner has rejected Claims 1-4, 6, 8-12, 17-20, 23-28, 30, 32-34 and 38-39 as anticipated by US 4,612,684 (Kollross).

These rejections are not appropriate and should be withdrawn with respect to the claims that have not been canceled. Although Applicant does not agree with the Examiner's rejections, some claims have been cancelled to expedite prosecution.

Rejections based on Kollross are misplaced. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The claims, as originally presented and as amended, are not anticipated.

### With respect to Claim 1:

Kollross is a complex stuffing machine that uses clamps to pull a rigid suspension loop off of a tape so that a clip can straddle the loop (one prong through the loop and one prong outside the loop). Kollross uses sensors and photocells to determine when the rigid loop is in range (i.e., in position) to be pulled by the clamps.

The clamping means and sensor are described with reference to Col. 5:

Associated to each clamping means 40 is a sensing means 68 which in the example of embodiment comprises a photocell 70 including a light source 72 arranged opposite thereto. The sensing means 68 is disposed--viewed in the longitudinal direction of the guide rail 36--respectively at a predetermined distance ahead (upstream) of the associated clamping means 40 and over the guide rail 36 and is laterally staggered such that the suspension loops 34 when sliding on the guide rail 36, will pass through the light beam of the light source 72 thereby generating a signal in the photocell 70 processed in an

electronic control means (not shown) to form a pulse for opening a magnetic valve (not shown) associated with the power cylinder 66 of the following (downstream) clamping means 40.

\* \* \*

FIGS. 3 to 5 and 7 to 10, in enlarged scale, illustrate the construction of the constricting and closing means 18 and a part of the loop feeding mechanism 20 by way of which the series arranged loops 34 disposed on a belt 74 in opened position, are fed to mechanical jaw 76 of the constricting and closing mechanism 18. The constricting and closing mechanism 18 comprises four such mechanical jaws 76, 78, 80, 82 disposed in pairs ahead of and behind a clipping unit 84 and pivotable about an axis 86 passing through an oblong hole 88 in the clipping unit 84.

And in contrast to Applicant's use of flexible loops, e.g., strings, the suspension loops of Kollross are substantially rigid. Note from Figs. 3 and 5 of Kollross how the loop portion stands out when the tape is bent. Also with reference to Col. 7, the alternatives presented in Kollross for the suspension loops are all substantially rigid:

It is apparent that the present invention is not restricted to the use of "closed" suspension elements, i.e. suspension loops. It will rather also be possible to use differently formed suspension elements, such as, for example, hooks, shafts having thickened heads guided into sectional grooves of the guide rail and of the curing or cooking sticks to be specifically formed for this purpose, and the like. In those cases it would not be required to hold the curing or cooking sticks in floating manner on one side, as would be inevitable when using suspension loops.

This distinction is important for some applications to overcome problems associated with substantially rigid suspension elements, such as those of Kollross. Customers are

dissatisfied with these substantially rigid suspension structures (see pp. 1-2 of the subject application) because, among other complaints, these types of structure slide around. Applicant's invention, by contrast, uses strings, i.e., flexible support members. Another significant difference is that Applicant's invention places the string loop in the path of the clip without the use of the mechanical jaws 76 of Kollross. Thus, for some embodiments, an inventive aspect is providing means for autonomous application of flexible suspension loops.

The prior art does not suggest use of flexible loops or means of accomplishing such use. Some embodiments transfer the string loop directly from the tape to the path of the clip by directing the loop into an entry in a guide slot of the clipping device. And a further distinction, in some claims, is that in Applicant's invention, the clip straddles both legs of the loop; the device disclosed in Kollross cannot do this and does not suggest doing so.

And a note with respect to Claim 6 dependent from Claim 1. The Examiner is mistaken in that Kollross discloses a tied loop. As best seen in Fig. 9, those are tabs or discs that secure the substantially rigid suspension loop ends.

With respect to Claims 9, 17-18, 23:

*Kollross*

Kollross does not disclose mirror image clips or the requisite structure to double clip the casing with spaced apart clips and sever the casing between the clips.

With respect to the corresponding dependent and method claims:

The inventive nature of each of the corresponding dependent and method claims will be apparent from the claim amendments and in view of the above comments.

### *Whittlesey*

Claims 21 and 40 have been rejected as anticipated by US 5,885,150 (Whittlesey). These rejections based on Whittlesey are misplaced and should be withdrawn, with respect to the claims that have not been canceled to expedite prosecution.

Whittelsey discloses a conveying system that has an upper conveyor belt and a separate lower conveyor belt – See Fig. 4 of Whittelsey. Claims 21 and 40, by contrast, utilize a conveyor that has a variable length conveying surface. The conveying surface is varied by use of movable slacker idler rollers. The prior art does not disclose a telescopic conveyor belt that allows the conveying surface to be varied by moving slacker idler rollers.

### **Claim Rejections - 35 U.S.C. § 103**

#### Plewa

Claims 5 and 29 are rejected over Kollross and Plewa. Applicant submits that this rejection is misplaced. First, in view of the comments with respect to Claim 1, not all the elements of Claims 5 and 29 are disclosed in the art. Second, the Examiner is mistaken with respect to Plewa – it does not disclose an air source for directing loops. The air source in Plewa, associated with bore 36, is part of a pressure sensor to determine when the label is removed. See Col. 6, lines 29-34. Plewa has nothing to do with an air source for directing loops into the path of a clip to capture the loop between the clip and the food casing.

#### Stanley

Claims 7 and 31 are rejected over Kollross and 4,949,429 (Stanley). This rejection is also not appropriate. Again, in view of the comments with respect to Claim 1, not all the elements are disclosed in the prior art. And with respect to Stanley – that reference is for a twin horn, it does not disclose a food product cut-off valve. And there are not sub-elements disclosed in Stanley that match the elements of the claimed food product cut-off valve.



Claims 13, 14-15, 35-36, 16 and 37, and 22:

In view of the above comments, the elements of Claims 13, 14-15, 35-36, 16 and 37, and 22 are not found in the prior art and are patentable.

The Claims Are Patentable Over the Art of Record

The Examiner has failed to set forth a *prima facie* case of obviousness. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983).

Although the claimed invention may seem simple, “the simplicity of new inventions is often the very thing that is not obvious before they are made . . . The fact that the invention seems simple after it is made is not determinative of the question of obviousness.” *In re Van Wenderhorn, Worthley, and Conolli*, 154 USPQ 20, 24 (CCPA 1967). The question of obviousness under 35 U.S.C. § 103 is whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 218 USPQ 871 (Fed. Cir. 1983). An argument that the invention is obvious because of a “combination of old elements” improperly analyzes the invention by its parts, instead of by its whole as the statute requires. *Custom Accessories, Inc., v. Jeffrey-Allan Industries, Inc.*, 1 USPQ2d 1197 (Fed. Cir. 1986). And hindsight must be avoided in combining reference structures. *Panduit Corp. v. Dennison Manufacturing Co.*, 227 USPQ 337, 343 (Fed. Cir. 1985).

“When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. *In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002), citing *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52 (Fed. Cir. 2001) (“the central question is whether there is reason to combine [the] references,” a question of fact drawing on the *Graham* factors).

“ ‘The factual inquiry whether to combine references must be thorough and searching.’ ” *Id.* “It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with.” *Id.* citing *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000) (“a showing of a suggestion, teaching, or motivation to combine the prior art references is an ‘essential component of an obviousness holding’ ”) (quoting *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 1994, 1999 (Fed. Cir. 1999) (“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”); *In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988) (“ ‘teachings of references can be combined *only* if there is some suggestion or incentive to do so.’ ”) (emphasis in original) (quoting *ACS Hosp. Sys, Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577 (Fed. Cir. 1984)).

“The need for specificity pervades this authority. *Id.* citing *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”); *In re Rouffet*, 149 F.3d 1350, 1359 (Fed. Cir. 1998) (“even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.”); *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references”).

“It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to ‘[use] that which the inventor taught against its teacher.’ ” *In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002) citing *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983).


## Conclusion

In view of the foregoing amendments and arguments, it is believed that the application is in condition for allowance and favorable action to that end is requested. Applicant respectfully requests reconsideration of the subject application.

It is believed that no other fee is presently due; however, should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Jenkins & Gilchrist, P.C. Deposit Account No. 10-0447, Order No. 54916-00334USPT.

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Respectfully submitted,



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